

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kenneth D. Simone, Jr.
Serial No.: 09/658,298
Filed: September 8, 2000
Group No.: 2142
Confirmation No. 3516
Examiner: Beatriz Prieto
Title: METHOD AND APPARATUS FOR COMMUNICATING
DURING AUTOMATED DATA PROCESSING

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicant contends that the rejections of Claims 1-10, 12, and 14 contain clear legal and factual deficiencies, as described below. In the Final Office Action dated March 14, 2006, the Examiner rejected Claims 1-10, 12, and 14 as unpatentable over Workflow Management Coalition the Workflow Reference Model, Hollingsworth D., TC00-1003, Jan. 95 ("*Hollingsworth*") in view of U.S. Patent No. 5,907,837 issued to Ferrel, et al. ("*Ferrel*") in further view of U.S. Patent No. 6,628,824 issued to Belanger ("*Belanger*"). Additionally, Claim 1 was rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant requests a finding that these rejections are improper and an allowance of these claims.

I. Section 101 Rejections

Claim 1 was not properly rejected under 35 U.S.C. § 101, as the claim is, in fact, directed to statutory subject matter. Claim 1 is a method claim. However, the Examiner seems to reject Claim 1 on the grounds that the claim "do[es] not seem to be described as being implemented in [] and/or limited to any tangible embodiment(s) (e.g. hardware components)." *Previous Office Action*, p. 7 (mailed September 21, 2005). As argued by Applicant (Response mailed May 15, 2006), Section 101 specifically identifies process claims as patentable subject matter, and Claim 1 does not fall into any of the categories of unpatentable process claims listed by the M.P.E.P. M.P.E.P. § 2106 (*see* section IV.B.1). Accordingly, Applicant respectfully submits that the Examiner has rejected Claim 1 as if it were a software-type claim rather than a method claim.

Thus, Applicant respectfully submits that Claim 1 is directed to statutory subject matter and is not properly rejected under 35 U.S.C. § 101. Accordingly, Applicant respectfully requests reconsideration and allowance of Claim 1.

II. Section 103 Rejections

Independent Claim 1 is allowable because the *Hollingsworth-Ferrel-Belanger* combination fails to teach or suggest each and every limitation of the claim. For example, none of the references, whether taken alone or in combination, teach or suggest that

transmitting a communication occurs after editing a predetermined number of images, as required by Claim 1.

As teaching these claimed aspects, the Examiner points to all three references, but appears to rely on *Belanger*, column 9, lines 32-42. *Final Office Action*, p. 4. Even assuming, for the sake of argument, that *Belanger* teaches sending a notification when a predetermined number of images condition is satisfied (as asserted by the Examiner), *Belanger* still fails to teach or suggest that transmitting the communication occurs after editing a predetermined number of images, as required by Claim 1. The cited portions of *Belanger* discuss an alarm or notification feature that is sent or displayed, but fail to discuss or even suggest anything that is sent or displayed after editing images. Even if *Belanger* teaches processing a predetermined number of images, *Belanger* does not teach or suggest editing a predetermined number of images, much less other claimed aspects.

Applicant thus respectfully submits that *Hollingsworth*, *Ferrel*, and *Belanger*, whether taken alone or in combination, fail to teach or suggest, each and every element of Claim 1. Likewise, independent Claim 7 includes limitations that, for substantially similar reasons, are not taught or suggested by the references. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 1 and 7, and their respective dependent claims.

CONCLUSION

As the rejections of Claims 1-10, 12, and 14 contain clear deficiencies, Applicant respectfully requests a finding of allowance of Claims 1-10, 12, and 14. If the PTO deems that an interview is appropriate, Applicant would appreciate the opportunity for such an interview. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Date: June 12, 2006

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